

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket № 14281US02)

In the Application of)
Jeyhan Karaoguz, et al.) **Electronically Filed on 23-APR-2008**
Serial No. 10/675,653)
Filed: September 30, 2003)
For: MEDIA PROCESSING SYSTEM)
AUTOMATICALLY OFFERING)
ACCESS TO NEWLY AVAILABLE)
MEDIA IN A MEDIA EXCHANGE)
NETWORK)
Examiner: Lajuania N. Mouzon)
Group Art Unit: 2153)
Confirmation No. 5800)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on January 23, 2008 (hereinafter, the Final Office Action) with a period of reply through April 23, 2008. The Applicant also requests review of the arguments stated on page 2 of the Advisory Office Action mailed on April 21, 2008 (hereinafter, the Advisory Office Action). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-30, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-7, 9, 11-17, 19, 21-27, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,644,714, issued to Kikinis (hereinafter, Kikinis). Claims 8, 10, 18, 20, 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of U.S. Patent No. 5,913,032, issued to Schwartz, et al. (hereinafter, Schwartz). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTIONS UNDER 35 U.S.C. § 102**I. Kikinis Does Not Anticipate Claims 1-7, 9, 11-17, 19, 21-27, and 29**

The Applicant first turns to the rejection of claims 1-7, 9, 11-17, 19, 21-27, and 29 under 35 U.S.C. 102(b) as being anticipated by Kikinis. With regard to the anticipation rejections under 102, MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

A. Rejection of Independent Claims 1, 11, and 21

With regard to the rejection of independent claim 1 under 102(b), the Applicant submits that Kikinis does not disclose or suggest at least the limitation of “comparing by said at least one media processing system, said one or more of said newly available media, data and service with data in **a media profile associated with said at least one media processing system**,” as recited by the Applicant in independent claim 1 (emphasis added).

The Examiner relies, in the Final Office Action, on Figures 1A and 2 of Kikinis, which illustrate a Video Jukebox world-wide architecture. Referring to Figure 1A, **Kikinis discloses that the individual clients 17-39 specify the topics of their particular interests. More specifically, paying clients of the video service, at the time of subscription, specify the topics of their particular interests.** See Kikinis, col. 4, lines 10-13. The Applicant points out that this is the only relevant disclosure by Kikinis of a "profile". Obviously, the "profile" relates to each of the subscribing clients 17-39. In addition, since the file servers send a message to the clients appropriate to their subscription and the interests they have indicated at the time of subscription to the service, the "profile" of each of the clients 17-39 is maintained and stored by the file server corresponding to the particular client.

As clearly seen from the above Final Office Action citation, **the Examiner has equated Kikinis' file servers 1-7 to Applicant's "media processing system."** However, as clarified above, Kikinis' "profile" relates to the subscribing clients 17-39, and the "profile" does not relate to the file servers 1-7 (equated by the Examiner to "media processing systems"). Therefore, Kikinis does not disclose "comparing by said at least one media processing system, said one or more of said newly available media, data and service with data in a media profile associated with said at least one media processing system," as recited by the Applicant in independent claim 1.

In the Advisory Office Action, the Examiner states the following: "It is clearly taught in Kikinis's Col. 4 line(s) 10-24, that paying clients (i.e. subscribers) sets up a profile, that includes specify topics of their particular interest, at the time of subscription. *The profile is associated with the system (file server) that sends the file (clipping) to the client (subscriber).*" The Applicant respectfully disagrees and refers the Examiner to the above arguments, where it is explained why the profile is associated with the subscribing clients and it is not associated with the file servers 1-7.

The Applicant points out that in the previous non-final Office Action (dated August 27, 2007), the Examiner equated Applicant's "media processing system" to the

clients 17-39. The Applicant overcame this argument in the November 5, 2007 response, and illustrated why Applicant's claims are not anticipated by Kikinis. The Examiner changed her mind and has now equated Applicant's "media processing system" to the file servers 1-7. The Applicant points out that this argument has also been overcome at least for the above reasons.

Accordingly, independent claim 1 is not anticipated by Kikinis and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-7, 9, 12-17, 19, 22-27, and 29

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(b) as being anticipated by Kikinis has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-7, 9, 12-17, 19, 22-27, and 29 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-7, 9, 11-17, 19, 21-27, and 29.

REJECTIONS UNDER 35 U.S.C. § 103

II. Rejection of Dependent Claims 8, 10, 18, 20, 28, and 30

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(b) as being anticipated by Kikinis has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Schwartz) does not overcome the deficiencies of Kikinis, claims 8, 10, 18, 20, 28, and 30 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 8, 10, 18, 20, 28, and 30.

III. Conclusion

The Applicant respectfully submits that claims 1-30 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 23-APR-2008

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